

REMARKS

Claims 1-10 and 13-42 are pending in the application and are currently rejected. Claims 11 and 12 are cancelled. Claims 1, 14 and 17 are currently amended. Claims 27-42 are new. In light of the amendments and remarks herein, which the Applicants believe place the claims in order for allowance, reconsideration of claims 1-10 and 13-42 is respectfully requested.

Amendments to the Specification

The Specification has been amended to address the Examiner's objections. No new matter has been added to the Specification.

Allowable Subject Matter

Applicants note with appreciation that claims 12, 14 and 17 have been deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, claims 14, and 17 have been rewritten in independent form. The allowable subject matter of claim 12 has been incorporated into amended independent claim 1.

Amendments to the Claims

While Applicants believe that the previously presented claims are patentable over all of the art cited in the Office Action as well as all other references submitted by Applicants, the claims have nonetheless been amended as follows in order to expedite the allowance of the claims. The amendments are therefore made without prejudice or disclaimer, and Applicants reserve the right to pursue the original scope of the claims as provided prior to the cancellation or amendments, such as through continuation practice.

Claim 1 is amended to recite an apparatus having a thermally conductive element that comprises a fluid heat transfer medium. The requirement was a limitation of dependent claim 12, which the Examiner indicated was allowable if rewritten in independent form.

Claim 14 is amended to add the limitations of claim 1, and is now rewritten in independent form.

Claim 17 is amended to add the limitations of claim 1, and is now rewritten in independent form. Claim 17 is also amended to change “applicator body” to “body” to remove potential ambiguity regarding antecedent basis for the term.

Claims 27-34 are new claims dependent from currently amended claim 14. These dependent claims parallel and are similar to existing dependent claims 2, 3, 6, 9, 15, 16, 23 and 26 respectively.

Claims 35-42 are new claims dependent from currently amended claim 17. These dependent claims parallel and are similar to existing dependent claims 2, 3, 6, 9, 15, 16, 23 and 26 respectively.

As such, the amendments to claims 1, 14, 17 and 27-42 do not add new matter.

Double Patenting

The Examiner provisionally rejected claims 1-16 and 18-26 based on obviousness-type double patenting as being unpatentable over various claims in co-pending U.S. Patent Application Nos. 10/776,686 (the “‘686 Application”), 10/776,687 (the “‘687 Application”), and 10/777,022 (the “‘022 Application”). Each of the ‘686, ‘687 and ‘022 Applications are currently pending and non-final office actions have been issued in each of the applications. Because the Double Patenting Rejections in this application are provisional and the claims in this application are in order for allowance, the Applicants request that the Examiner withdraw the rejection in this case, and address any Double Patenting issues in the ‘686, ‘687 and ‘022 Applications, if necessary, as those applications are prosecuted. Assuming that otherwise allowable claims in the ‘686, ‘687 and ‘022 Applications would claim the same subject matter as the allowable claims of the present application, the Applicants are prepared to either file a terminal disclaimer in the applicable case(s) or submit an appropriate amendment to the claims of each application to overcome any remaining obviousness-type double patenting objection.

Claim Rejections - 35 U.S.C. § 102 and § 103

Claims 1-8, 10, 15-16, 18-22 and 26 are rejected under 35 U.S.C. §102(b) as being anticipated by WO 98/06345 to Chen et al. ("Chen"). Further, claims 1, 9, 13 and 23-25 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,862,771 to Muller ("Muller") in view of U.S. Patent Application Publication US 2003/0113684 to Scott ("Scott") and in further view of various other references. These claims are novel, however, because none of Chen, Muller, Scott and the other cited references teach or suggest the elements recited in the claims as currently amended.

Claim 1 as amended recites an apparatus having a thermally conductive element that comprises a fluid heat transfer medium. The Examiner has indicated that claim 12 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Therefore, Applicants have amended claim 1 to include the limitations of previous (now-canceled) dependent claim 12. Applicants, therefore, submit that claim 1 is now in order for allowance.

Similarly, Claims 2-10, 13, 15-16 and 18-26, which are dependent from Claim 1, are patentable for at least the same reasons.

Claim 14 as amended recites the limitations of claim 1, and is now rewritten in independent form. The Examiner has indicated that claim 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Therefore, Applicants have amended claim 14 to include the limitations of previously presented claim 1. Applicants, therefore, submit that claim 14 is now in order for allowance.

Similarly, new claims 27-34, which are dependent from Claim 14, are patentable for at least the same reasons.

Claim 17 as amended recites the limitations of claim 1, and is now rewritten in independent form. The Examiner has indicated that claim 17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Therefore, Applicants have amended claim 17 to include the limitations of previously presented claim 1. Applicants, therefore, submit that claim 17 is now in order for allowance.

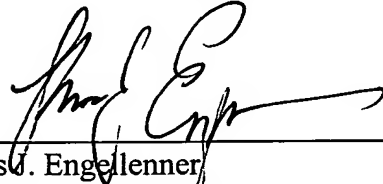
Similarly, new claims 35-42, which are dependent from Claim 17, are patentable for at least the same reasons.

CONCLUSION

In summary, the Applicant's appreciate the Examiner's statement regarding the allowable subject matter in the application. The claims in the application have been amended accordingly, and the Applicants submit that they are in order for allowance. Therefore, reconsideration is respectfully requested for all the reasons set forth above. In the event that the amendments and remarks are not deemed to overcome the grounds for rejection, the Examiner is kindly requested to telephone the undersigned representative to discuss any remaining issues.

Respectfully submitted,

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